

Application No. 09/878,245

REMARKS

Claims 15-17 are currently pending.

CLAIM REJECTIONS

Claim 15-17 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,722,418 to Bro. Applicant respectfully traverses this rejection.

For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. "Every element of the claimed invention must be literally present, arranged as in the claim. The identical invention must be shown in as complete detail as is contained in the patent claim." *Richardson v. U.S. Suzuki Motor Corp.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989); see also MPEP § 2131. "[a]nticipation is not shown by a prior art disclosure which is only 'substantially the same' as the claimed invention." *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 225 U.S.P.Q. 253, 256 (Fed. Cir. 1985).

Bro does not disclose a "prediction system for assessing a suitability of job applicants" as that element is recited by claims 15-17. As evidence that Bro purportedly teaches Applicant's recited claim limitations, the Examiner points to Col. 19, lines 39-41 which states: "assess and predict more accurately the degree of crystallization of a person's attitudes and resulting behavior". The "prediction" taught by Bro is directed to behavior generally and is designed for use with *existing patients and employees*. (Col. 9, lines 14-20). There is nothing at all in Bro that even mentions *future job applicants*, let alone the *suitability* of such applicants for a job opening.

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More importantly, the Examiner fails to identify where in Bro there is express disclosure of success at a given job. The Examiner also fails to identify where in Bro there is any teaching of using Bro's method on prospective job applicants. As laid out by the citations above, the Examiner is required under 35 U.S.C. § 102 to particularly point out every element of the claimed invention. Because the Examiner has failed to identify these two elements in Bro, Applicant maintains that the § 102 rejection is improper.

Also, as evidence that Bro teaches the claimed limitation of a scoring system and a scoring database, the Examiner points to Co. 9, lines 20-42 which describes a database that stores questions and responses (test) data from and to a patient or an employee and which states:

- (a) means for recording and accessing a patient's database that includes for each patient the name, schedule of telephone numbers where the patient may be reached during each 24-hour period, personal identification number, and previous history of messages and the patient's responses;
- (b) means for measuring and recording a patient's weight without revealing their weight to them and transmitting said weight information telephonically for use in a weight reduction program;
- (c) first means for recording and accessing a patient's or employees program that includes for each patient or employee specific motivational messages, personal and unique metaphoric references, goals, and/or questions that are to be responded to by the patient or employee through either the telephone, one- or two-way interactive beeper, personal communicator, modem, personal computer, or interactive television;
- (d) a computer having means for accessing the patient database and said patient or employee program.

The language the Examiner points to is referring to Bro's method for storing motivational phrases to be read to an *existing patient or employee*. Bro simply does not teach anything remotely resembling a testing question to be asked to a *prospective employee*, let alone a

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question that has been validated. Because the Examiner has failed to identify this additional element in Bro, Applicant maintains that the § 102 rejection is improper.

For at least these reasons, Applicant respectfully requests the rejection to claim 15-17 be withdrawn. In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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